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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,723	10/30/2000	Joel Erwin Goldstein	06076-USA	6932

23543 7590 09/16/2002

AIR PRODUCTS AND CHEMICALS, INC.
PATENT DEPARTMENT
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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 09/16/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/699,723

Applicant(s)

GOLDSTEIN ET AL.

Examiner

Judy M. Reddick

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/05/02;06/12/02.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Claim Objections

1. **Claim 4 is objected to because of the following informalities: In claim 4 @ line 6, "and" should be inserted before "ethyl 2-hydroxy-2 sulfinato propionate-sodium salt" so as to engender proper Markush format . Appropriate correction is required.**

Claim Rejections - 35 USC § 112

2. **The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. **Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**
 - A) **The recited "2-hydroxy-2-sulfinato propionatic acid-disodium salt" per claim 4 engenders non-art recognized terminology. Perhaps "2-hydroxy-2-sulfinato propionate-disodium salt" is what is intended by applicants.**
 - B) **The recited "catalytic system" per claim 5 constitutes indefinite subject matter as per the non-express establishment of proper antecedent basis.**

Claim Rejections - 35 USC § 103

4. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**
5. **Claims 1-7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Pinschmidt, Jr. et al or Weist et al in combination with Applicants' own disclosure as per reasons clearly set forth in the Grounds of rejection per a previous Office Action of paper no. 3, 12/03/01, paragraph no. 5.**

Response to Arguments

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6. ***Applicant's arguments filed 03/05/02 and 06/12/02 have been fully considered but they are not persuasive.***

Relative to the 112, 2nd paragraph issues---***While Counsel, in a good faith effort, attempted to remedy the 112, 2nd paragraph issues raised in a previous Office Action, some issues still remain and are as set forth supra.***

Relative to Pinschmidt, Jr. et al or Weist et al/Applicants' own disclosure---***It is urged and maintained that the instantly claimed invention is obvious within the meaning of 35 USC 103 over Pinschmidt, Jr. et al or Weist et al in combination with Applicants' own disclosure as per reasons clearly set forth in the Office Action of paper no. 3, 12/03/01, paragraph no.***

5.

While Counsel argues that a prima facie case of obviousness, based on a reference to Mudge et al(U.S. 5,540,987) and not used in a prior art rejection, has been adequately rebutted via showing that the claimed reducing agent(Tradename Bruggolite FF-6) provides unexpected and superior results over the reducing agent(ascorbic acid) of Mudge, there is no evidence on this record showing that the claimed reducing agent is unexpectedly superior to the reducing agents disclosed per Pinschmidt, Jr. et al and Weist et al.with the understanding that the aforementioned prior art is believed to be closer to the claimed invention than that of the prior art to Mudge et al referenced by Counsel. Data demonstrated by applicants via an affidavit or declaration under 37 CFR 1.132 must compare the claimed subject mater with the closest prior art to be effective to rebut a prima facie case of obviousness as provided for under the auspices of In re Burckel, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979).

Conclusion

7. ***THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).***

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date f this action. In the event a first reply is filed within TWO MONTHS of the


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mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.


Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR 
September 13, 2002